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| APPLICATION NO.           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 09/843,396                | 04/26/2001  | Stefan Dutzmann      | Mo5334/LeA 32,232   | 4187             |
| 34469                     | 7590        | 06/17/2004           | EXAMINER            |                  |
| BAYER CROPSCIENCE LP      |             |                      | CHOI, FRANK I       |                  |
| Patent Department         |             |                      | ART UNIT            | PAPER NUMBER     |
| 100 BAYER ROAD            |             |                      |                     |                  |
| PITTSBURGH, PA 15205-9741 |             |                      | 1616                |                  |

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/843,396             | DUTZMANN ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Frank I Choi           | 1616                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 6-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 6-9 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/402,866.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 20010426.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claim 6 is rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. US Pat. 6,624,183, 6,297,236 and 6,620,822 each disclose the combination of prothioconazole with at least one of the other fungicidal compounds (US 6,620,822, Column 1, lines 30-68, Columns 2,3; US 6,297,236, Column 1, lines 55-68, columns 2-6, column 7, lines 1-30; US 6,624,183, Columns 2-13, Column 14, lines 1-50). However, each of said patents have a different inventive entity than the present invention. As such, it appears that applicant did not invent the claimed subject matter.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art in view of US Pat. 3,903,090.

Applicant acknowledges that prothioconazole has good fungicidal activity but at low application rates it is in some cases not satisfactory (Specification, Pg. 1). Applicant acknowledges that a large number of triazole derivatives, aniline derivative, dicarboimides and

other heterocycles can be employed for controlling fungi, such as set forth in EP A 0 040 345, DE A 2 201 063, DE –A 2 324 0 10, Pesticide Manual, 9<sup>th</sup> ed (1991), pages 249 and 827, U S Pat. No. 3, 903, 090 and EP – A 0 206 999, and that likewise these compounds are not always satisfactory at low application rates (

Specification Pg. 1).

US Pat. 3,903,090 discloses that the N-(3,5-dihalophenyl)-imide compounds can be extended with suitable carriers and can be combined with other fungicides (Column 32, lines 20-39).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the combination of prothioconazole with the other fungicides. However, the prior art amply suggests the same as it is known that that the compounds used singly are effective fungicides, and that fungicides can be combined together and be formulated with suitable extenders. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to combine prothioconazole with one or more of the other fungicides with the expectation that the combination would be an effective fungicide and that that the formulations could be extended with suitable carriers.

“It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” In re Kerkhoven, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be *prima facie* obvious.). See also In re

Crockett, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote the formation of a nodular structure in cast iron.); and Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held *prima facie* obvious).

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being obvious over WO 96/126048. WO 96/126048 discloses the combination of prothioconaozole with other fungicides, including propineb, dimethomorph and fosetyl-aluminum, to widen the spectrum of action, to prevent build of resistance and that the activity of the mixture in many cases exhibits synergistic activity and that the formulations are prepared in a known manner, for example by mixing the active compounds with surfactants and extenders, and that application concentrations of the active compounds depend on the nature and occurrence of the microorganisms to be controlled and on the composition of the material to be protected and the optimum amount to be employed can be determined by a series of tests (see entire reference, especially, Pg. 42, lines 11-15, Pg. 43, lines 15-30, Pg. 44, Pg. 47).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the combination of prothioconaozole with the other fungicides. However, the acknowledged prior art amply suggests the same as it is known that that the compounds used singly are effective fungicides, that prothioconazole can be combined with other fungicides and

that they can be formulated with surfactants and extenders. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to combine prothioconazole with one or more of the other fungicides with the expectation that the combination would be more effective than each alone and that surfactants and extenders would be suitable for use in the formulation.

“It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” *In re Kerkhoven*, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be *prima facie* obvious.). See also *In re Crockett*, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote the formation of a nodular structure in cast iron.); and *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held *prima facie* obvious).

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Conclusion***

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Thurman Page, can be reached at (571)272-0602. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

FIC

June 14, 2004



JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600